

**REMARKS**

Claims 1-17 are pending in the above-referenced patent application.

Claims 1-4 and 9-17 have been rejected.

Claims 5-8 have been objected to

No claims have been allowed.

Claim 9 and 13 have been amended.

Claims 1-17 remain in this Application.

Reconsideration of the claims of this Application is respectfully requested.

**Objection to Drawings**

In section 1 of the December 10, 2003, Office Action, the Examiner objected to the drawings because reference character “ 22’ ” had been used to indicate two elements of Figure 1. The Applicant proposes to amend the drawings by changing to “ 22 ” the reference character of the network control box connecting controller 12 in Figure 1, and by adding the legend “Prior Art” to Figures 1 and 2, as shown in the attached sketches in red ink. The Applicant respectfully submits that no new matter has been added and requests entry and acceptance of the proposed drawing correction and withdrawal of the objection.

**Objection and Amendments to the Specification**

In section 2 of the Office Action, the Examiner objected to the abstract of the disclosure

because it exceeded 150 words. The Applicant has amended the Abstract not to exceed 150 words. The Applicant respectfully requests withdrawal of the objection.

Furthermore, three paragraphs of the Specification have been amended to correct typographical errors. The Applicant respectfully submits that no new matter has been added with the amendments.

#### **Allowable Subject Matter**

The Applicant thanks the Examiner for the indication in section 3 of the Office Action that Claims 2-4 would be allowable if rewritten in independent form. However, because the Applicant believes that Claims 2-4 depend from an allowable base claim, as described below, the Applicant has not rewritten Claims 2-4 in independent form.

#### **Claim Objections**

In section 4 of the Office Action, the Examiner objected to Claim 9 because of informalities. The Applicant has amended Claim 9 in conformance with the Examiner's suggestion and respectfully requests withdrawal of the objection.

**35 U.S.C. § 112**

The Examiner rejected Claims 1-8 and 12-17 under 35 U.S.C. § 112 in section 6 of the Office Action as being incomplete for omitting essential steps. The Applicant respectfully traverses the objection.

With regard to independent Claim 1, the claimed binding procedure begins with the step of transmitting an Address Inquiry signal, thus the claim recites neither the step of transmitting an Address Request signal nor transmitting a Stop Transmission signal. As such, the Applicant respectfully asserts that Claim 1 omits no essential step.

With regard to independent Claim 12, the Applicant respectfully asserts that the step of sending a Stop Transmission signal is not disclosed to be essential to the invention as described in the specification or in other statements of record. A Stop Transmission signal is not sent in the method described in the Summary of the Invention. As the Examiner has pointed out, the step is also not part of the method recited in Claim 12, which establishes a disclosure under MPEP § 608.01(l). Furthermore, where the Stop Transmission signal is described in the specification, at page 17, lines 17-22, it is not described as occurring before any addresses are received subsequent to the first address. It is simply described as forestalling transmission by “the available lamps that have not already transmitted their addresses.” Specification, page 17, lines 20-21. Thus, the Applicant respectfully asserts that sending the Stop Transmission signal is not essential to the invention as described in the specification and, therefore, Claim 12 omits no essential step.

With regard to Claim 13, the Applicant respectfully asserts that, as amended, the claim includes all matter essential to the invention and, therefore, respectfully requests withdrawal of the rejection.

For the reasons set forth above, independent Claims 1 and 12 and amended dependent Claim 13 include all matter essential to the invention. Therefore, the Applicant respectfully submits that Claims 1, 12 and 13 (and Claims 2-8 and 14-17, depending directly or indirectly therefrom) are allowable under 35 U.S.C. § 112. The Applicant respectfully requests that the rejection of Claims 1-8 and 12-17 under 35 U.S.C. § 112 be withdrawn and that Claims 1-8 and 12-17 be passed to allowance.

**35 U.S.C. § 102(e) Anticipation**

In section 8 of the December 10, 2003, Office Action, the Examiner rejected Claims 9 and 10 under 35 U.S.C. § 102(e) as being anticipated by Patent Application Publication No. US 2002/0175705 A9 of *Armstrong et al.* (hereafter "*Armstrong*"). In paragraph The Applicant respectfully traverses these rejections.

It is axiomatic that a prior art reference anticipates the claimed invention under 35 U.S.C. § 102(e) only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131. See, *In re King*, 231 USPQ 126, 138 (Fed. Cir. 1986) (citing with approval, *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 221 USPQ 481, 485 (Fed. Cir. 1984)); *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990).

Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131. *In re Donohue*, 766 F.2d 531, 534, 226 USPQ 619, 621 (Fed. Cir. 1985).

With respect to Claims 9 and 10, a determination of anticipation in accordance with Section 102(e) requires that each feature claimed therein be described in sufficient detail in *Armstrong* to enable one of ordinary skill in the art to make and practice the claimed invention.

Claim 9 has been amended to highlight a distinction between the Applicant's invention and the cited prior art. The transponder described in *Armstrong* transmits a response to a message from an interrogator in one of N sequential time slots following the message. When a transponder receives a Read Tag\_ID message it generates a random number that determines which time slot the transponder will use in responding to the message. Thus, in the system described in *Armstrong*, a random number generated in response to the receipt of the Read Tag\_ID message determines how long the transponder will delay before responding to the message. The Applicant has amended Claim 9 to clarify that the responding devices of the Applicant's invention respond after a predetermined amount of time. As such, every element of the Applicant's claimed invention is not identically shown in the *Armstrong* reference.

For the reasons set forth above, independent Claim 9 is not anticipated by *Armstrong*. Claim 10 depends directly from Claim 9 and includes its limitations. Therefore, the Applicant respectfully submits that Claims 9 and 10 are patentable over the *Armstrong* reference. The Applicant

respectfully requests that the rejection of Claims 9 and 10 under 35 U.S.C. § 102(e) be withdrawn and that Claims 9 and 10 be passed to allowance.

**35 U.S.C. § 103(a) Obviousness**

In section 10 of the Office Action, the Examiner rejected Claims 1-3, 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,337,619 to *Kowalski et al.* (hereinafter “*Kowalski*”) in view of *Armstrong*. In section 11 of the Office Action, the Examiner rejected Claims 4 and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over *Kowalski* and *Armstrong* in further view of U.S. Patent No. 6,133,832 to *Winder et al.* (hereinafter “*Winder*”). In section 12 of the Office Action, the Examiner rejected Claims 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Armstrong* in view of Patent Application Publication No. US 2002/0084890 A1 of *Guerrieri et al.* (hereafter “*Guerrieri*”). In section 12 of the Office Action, the Examiner rejected Claims 17 under 35 U.S.C. § 103(a) as being unpatentable over *Kowalski* and *Armstrong* in further view of *Guerrieri*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is

established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

With regard to independent Claims 1 and 12, the Examiner asserts without citation to the reference that the method of *Armstrong* includes transmitting a Read Tag\_ID command to transponders and determining from the received Tag\_IDs whether there is a transponder that has the same Tag\_ID as another transponder. See December 10, 2003, Office Action, page, 6, lines 17-21.

The Applicant respectfully disagrees and directs the Examiner's attention to paragraph [0063] of the *Armstrong* reference, lines 1-12:

In the event that it is found that the Tag\_ID of a particular transponder 150 is identical to an existing Tag\_ID stored in memory in host computer 100, the Replace Tag\_ID command may be used to replace the duplicate Tag\_ID with a separate and distinct Tag\_ID (FIG. 7). The identification of a duplicate Tag\_ID must be made prior to allowing the tagged article having a duplicate Tag\_ID to join the population of tagged articles containing its duplicate, e.g., there must be a staging area having a dedicated interrogator 190 which is used to identify the Tag\_IDs (using the Read Tag\_ID command) of tagged articles that are to be added to the general population of tagged articles.

This description makes it clear that the system described in *Armstrong* determines that a transponder has the same Tag\_ID as another transponder by isolating new transponders in a separate staging area, interrogating them, and comparing their Tag\_IDs with the existing Tag\_IDs stored in the memory of the host computer. As such, the system of the *Armstrong* reference does not teach transmitting an address inquiry signal to the address of a first device and determining whether one or more additional responses are received from one or more other devices, as recited in Claim 1.

Furthermore, while Claim 1 recites sending a randomize address signal to a particular address, *Armstrong* teaches sending a Re-select Tag\_ID command which is acted upon by all transponders that receive the command. See [0062], lines 29-30.

The Examiner stated that "Kowalski's method further lacks the steps of (f) determining whether one or more additional responses to address inquiry are received from one or more modules in the group and (g) instructing all devices having the same address to generate a random address."



(December 10, 2003 Office Action, page 6, lines 14-16). The Applicants agree that *Kowalski* does not disclose these steps. Nor does either the *Guerrieri* or *Winder* reference teach the steps.

Thus, the *Armstrong*, *Kowalski*, *Winder* and *Guerrieri* references, either alone or in combination, do not disclose, suggest or hint at all the claim limitations of independent Claims 1 and 12 and, therefore, a *prima facie* case of obviousness has not been established. Claims 2-4 and 13-17 depend, directly or indirectly, from Claims 1 and 12, and contain their respective limitations. The Applicant respectfully requests that the rejection of Claims 1-4 and 12-17 under 35 U.S.C. § 103(a) be withdrawn and that Claims 1-4 and 12-17 be passed to allowance.

With regard to Claim 11, the Applicant hereby reiterates and incorporates by reference all of the comments previously made in connection with the rejection of Claim 9 as being anticipated by the *Armstrong* reference under 35 U.S.C. § 102(e). Additionally, *Guerrieri* does not teach a device that transmits its address a pre-determined amount of time after receiving an address request signal. Thus, the *Armstrong* and *Guerrieri* references, either alone or in combination, do not disclose, suggest or hint at all the claim limitations of independent Claim 9. Claim 11, depending indirectly from Claim 9, contains all the limitations of Claim 9 and, therefore, a *prima facie* case of obviousness has not been established with regard to Claim 11. The Applicant respectfully requests that the rejection of Claim 11 under 35 U.S.C. § 103(a) be withdrawn and that Claim 11 be passed to allowance.

The Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicant reserves the right to

submit further arguments in support of his above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

**SUMMARY**

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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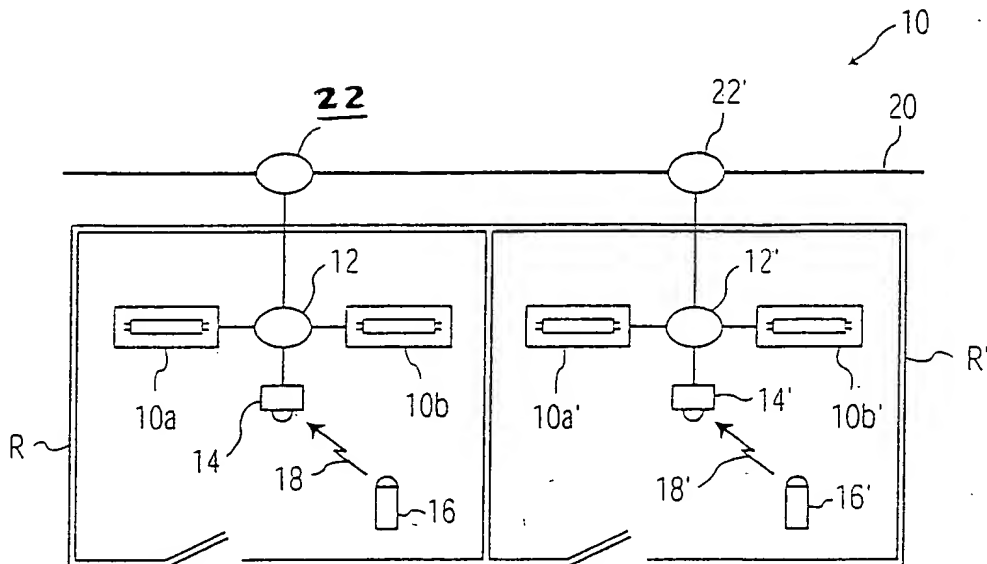


FIG. 1

PRIOR ART

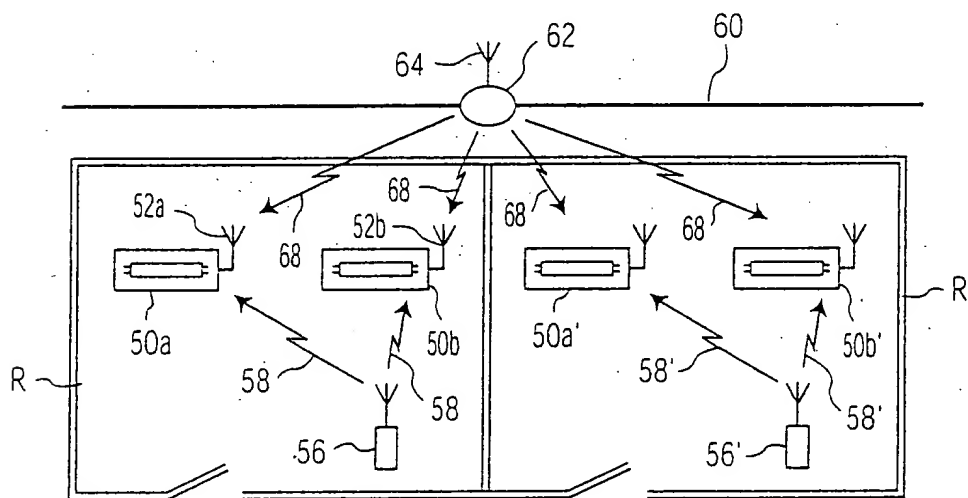


FIG. 2

PRIOR ART